



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,621	01/27/2004	Tsung-Yen Dean Chang	ACN-009 CON	3761

1473 7590 04/04/2008  
ROPES & GRAY LLP  
PATENT DOCKETING 39/361  
1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

EXAMINER
----------

EL-ZOOBI, MARIA

ART UNIT	PAPER NUMBER
----------	--------------

2614

MAIL DATE	DELIVERY MODE
-----------	---------------

04/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,621	<b>Applicant(s)</b> CHANG ET AL.	
	<b>Examiner</b> MARIA EL-ZOOBI	<b>Art Unit</b> 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/2004</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites the limitation "wherein the telephone further" which indicates that this limitation has been mentioned before in it is being further defined, how ever this limitation has not mentioned before, the parent claim 33, claiming a method that provide an apparatus, that enable applying the method, the claim does not specifically define a telephone.

Claim 38 is rejected as being depend on claim 37.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

Art Unit: 2614

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-57 of U.S. Patent No. 6, 70957. Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example the instant application claim 1 and the patent application claim 1 are both drawn to the same invention "an apparatus for switching between internet service and an analog service" although the claims are not identical, they are patentably not distinguish from each other.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-11, 13, 18 and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (US Patent 6,091,721) in view of Terschluse (US Patent 6,118,857).

Regarding claim 1, Greenberg discloses, an apparatus for selectively coupling an analog telephone circuit to either a telephone network or an Internet telephony service (Fig. 3, el. 30), the apparatus comprising:

a jack adapted to be coupled to the telephone network to pass analog signals to the telephone network (Fig. 3, el. 31 and Col. 5, lines 54-66 through Col. 6, lines 1-5)

a DTMF interface circuit adapted to be coupled to the analog telephone circuit (Fig. 3, el. 42 and Col. 6, lines 26-35) and

a switch coupled to the telephone (Fig. 3, el. 33), the switch having a first position wherein the telephone is coupled to the jack (Col. 5, lines 57-65) and a second position wherein the telephone is coupled to the interface (Col. 6, lines 35-39), the switch moving between the first and second positions responsive to detection of a predetermined sequence of DTMF digits through the DTMF interface circuit (Col. 6, lines 6-16 and 26-55)

Greenberg does not disclose an interface adapted to be coupled to a PC.

Terschluse discloses a modem for connecting a telephone to a computer (Fig. 1 and Col. 4, lines 33-40).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg with the teach of Terschluse to have the telephone connected to a computer, in order to enable the user to display information about the caller and the call.

Regarding claim 2, Greenberg in view of Terschluse discloses, wherein the

DTMF interface circuit further comprises a DTMF detection circuit (Greenberg: Col. 7, lines 13-22).

Regarding claim 4, Greenberg in view of Terschluse discloses, a hold circuit coupled between the jack and the interface (Terschluse: a call waiting signal may be received while a data connection is taking a place (Terschluse: Col. 5, lines 40-42), when the call is accepted, the connection controller receives a corresponding signal the data call is put on hold (Terschluse: Col. 5, lines 45-54; this way a user is able to put the first call on hold “the logic connection is maintained but the data flow is temporary stopped” and answer the second call without the need to disconnect from any of them).

Regarding claim 5, Greenberg in view of Terschluse discloses, a ring detection circuit coupled between the jack and the interface (Greenberg: Col. 7, lines 5-11; phone line interface that detect a ring signal).

Regarding claim 6, Greenberg in view of Terschluse discloses, an off-hook detection circuit coupled between the telephone and the interface (Greenberg: Col. 6, lines 20-29).

Regarding claim 7, Greenberg in view of Terschluse discloses, a modem detection circuit coupled between the jack and the interface (Green berg: Col. 7, lines 50-65; since the CPU switches the DTMF GEN and modem 50 to modem mode to

establish a connection, it is inherent to have a modem detection circuit that detect the modem of the other side to ensure the availability before establishing a connection).

Regarding claim 8, Greenberg in view of Terschlude discloses, a call-waiting detection circuit coupled between the jack and the interface (Terschlude: Col. 4, lines 56 through Col. 6, lines 1-39; the detection device el. 6 that detect the presence of a call waiting signal).

Regarding claim 9, Greenberg in view of Terschlude discloses, when the user lift the handset of the phone, establish an off-hook state condition which generate an off-hook indication signal, then the user enter a touch tone sequence then a ring tone is generated (Col. 5, lines 54-65 and Col. 6, lines 20-49).

Greenberg in view of Terschlude does not expressly teach line detection circuit coupled between the jack and the interface, but it is obvious that one with ordinary skill in the art, would recognize that a line detection circuit would have been provided for the purpose of determining the line is available to place a call).

Regarding claim 10, Greenberg in view of Terschlude discloses, the interface further comprises a microcontroller (Greenberg: Fig. 3, el. 40; CPU and memory will include a microcontroller).

Regarding claim 11, Greenberg in view of Terschlude discloses, circuitry for digitizing voice signals coupled to the interface (Greenberg: Col. 6, lines 44-55; digital/analog interface for converting analog signal to digital signals that are fed to the

Art Unit: 2614

CPU).

Regarding claim 13, Greenberg in view of Terschluse discloses, the interface is adapted to be coupled to an expansion slot of a PC (Terschluse: Col. 4, lines 33-35; the modem is connected to a computer via connectors 2a and 2b).

Regarding claim 18, Greenberg discloses, a method of selectively coupling an analog telephone circuit to either a telephone network or an Internet telephony service (Col. 1, lines 59-65 and Col. 5, lines 66-67 through Col. 6, lines 1-9) the method comprising:

- an analog telephone circuit and a telephone network ( Fig. 2 and also see Col. 5, lines 36-42)

- the apparatus including an interface (Fig. 2, el. 12)

- a DTMF interface circuit (Fig. 3, el. 42) and

- a switch coupled to the telephone and the DTMF interface circuit (Fig. 3, el. 33)

- the switch having a first position wherein the telephone is coupled to the telephone network (Col. 5, lines 57-65, also see Fig. 3) and a second position wherein the telephone is coupled to the interface (Col. 6, lines 35-39), the switch responsive to detection of a predetermined sequence of DTMF digits by the DTMF interface circuit (Col. 6, lines 6-16 and 26-55)

- coupling the apparatus to an analog telephone circuit, and the telephone network (Fig. 2 and Fig. 3) and if it is desired to connect to the telephone network, dialing a



Art Unit: 2614

telephone number while the switch is in the first position (Col. 5, lines 66-67 through Col. 6, lines 1-5)

if it is desired to place an Internet-based telephone call, entering the predetermined sequence of DTMF digits to cause the switch to move to the second position (Col. 6, lines 6-32).

Greenberg does not disclose providing apparatus adapted to be coupled to a PC or coupling the apparatus to a PC.

Terschluse in similar art of endeavor discloses a modem for connecting a telephone to a computer (Fig. 1 and Col. 4, lines 33-40), so when the user is on a phone and receive a second call, the second call will be received on the computer.

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg with the teach of Vaziri to have the telephone connected to a computer, in order to enable the user to receive another incoming call on the PC).

Regarding claim 20, Greenberg in view of Terschluse discloses, establishing an Internet-based telephone call (Greenberg: Col. 6, lines 6-7 and Col. 7, lines 13-14).

Regarding claim 21, Greenberg in view of Terschluse discloses, during the pendency of an Internet-based telephone call receiving a call-waiting signal that there is an incoming call on the first telephone network line; and generating a user-perceptible signal responsive to receipt of the call-waiting signal (Terschluse: Col. 4, lines 58-67 through Col. 5, lines 1-45).

Regarding claim 22, Greenberg in view of Terschluse discloses, entering the predetermined sequence of DTMF digits to cause the switch to move from the second to the first position; and accepting the incoming call (Greenberg: Col. 1, lines 33-40 and Col. 6, lines 6-16 and 26-55).

Regarding claim 23, Greenberg in view of Terschluse discloses, the apparatus further comprises a ring detection circuit (Greenberg: Col. 7, lines 5-11 also see claim 5), the method further comprising during the pendency of an Internet-based telephone call receiving an incoming call on the telephone network detecting the incoming call on the telephone network using the ring detection circuit; and generating a user-perceptible signal responsive to an output of the ring detection circuit (Terschluse: Col. 5, lines 30-67 through Col. 6, lines 1-25).

Regarding claim 24, Greenberg in view of Terschluse discloses, entering the predetermined sequence of DTMF digits to cause the switch to move from the second to the first position and accepting the incoming call on the telephone network (Greenberg: Col. 1, lines 33-40 and Col. 6, lines 6-16 and 26-55).

Regarding claim 25, Greenberg in view of Terschluse discloses, during the pendency of the call on the telephone network entering the predetermined sequence of DTMF digits to cause the switch to move from the-first to the second position; and resuming the Internet-based telephone call (Greenberg: Col. 1, lines 33-40 and Col. 6, lines 6-16 and 26-55).

7. Claim 3, 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (US Patent 6,091,721) in view of Vaziri (US Patent 6,377,570).

Regarding claim 3, Greenberg in view of Terschluse discloses, a subscriber line interface (Terschluse: Col. 2, lines 14-15 and Col. 3, lines 55-58) and switch that has two positions (see claim 1 analysis), the switch's second position is wherein the telephone is coupled to the interface (Col. 6, lines 35-39).

Greenberg in view of Terschluse does not expressly disclose that the subscriber line interface circuit, the subscriber line interface circuit coupled between the switch and the interface when the switch is in the second position.

In similar field endeavor, Vaziri discloses an internet switch box (ISB; Fig. 1, el. 100) that enable a user of making a regular phone call or a call over the internet (Fig. 7A, el. 100 and Col. 3, lines 21-30) and this box has a switch (Fig. 2, el. 210), this switch has two positions, a first one is to connect the phone to the line 212 and a second position to connect the phone to the controller Fig. 2, el. 201, Vaziri also discloses a subscriber line when the switch is on the second position (Fig. 2, el. 206)

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg in view of Terschluse to provide a subscriber line as taught by Vaziri in order to provide over voltage protection.

Regarding claim 16, Greenberg in view of Terschluse discloses, an interface.

Greenberg in view of Terschluse does not discloses, the interface is a serial port, a parallel port, or a Universal Serial Bus port .

Vaziri in similar art of endeavor, discloses apparatus (internet switch box ISB) when the user press a button on the apparatus or certain keys on the telephone; see abstract) this will enable the user of the phone to select a rout for a telephone call (conventional PSTN or internet; see Col. 2, lines 57-60), this apparatus contain a jack for connection to the telephone and optional port (serial parallel, universal serial bus for connection with a PC (Col. 12, lines 1-6).

Therefore, it would have been obvious to one with ordinary skill in the art to modify Greenberg in view of Terschluse to have the interface is a serial port or a Universal Serial Bus port, as suggest by Vaziri, in order to maximize the user convenience when need to add new hardware for the system.

Regarding claim 17, Greenberg in view of Terschluse and further in view of Vaziri discloses, the interface comprises a portion of a modem circuit (Terschluse: Fig. 1, el. 16).

Regarding claim 19, Greenberg in view of Terschluse discloses, entering the predetermined sequence of DTMF digits, launching an Internet-based telephony application (Greenberg: Col. 6, lines 6-59 and Col. 7, lines 55-65; so when choose to have internet cal, the user press a specific sequence that the adapter has been programmed to ; which will launch a specific software to allow the reception of the internet call)

Greenberg in view of Terschluse does not disclose, launch the internet telephony application on PC.

Vaziri in similar art of endeavor, discloses apparatus (internet switch box ISB) when the user press a button on the apparatus or certain keys on the telephone; see abstract) this will enable the user of the phone to select a rout for a telephone call (conventional PSTN or internet; see Col. 2, lines 57-60), this apparatus can be connected to a PC to enable another call to be received on the PC when the user press a specific buttons which will launch a specific script to enable this feature (Col. 15, lines 12-23 and 35-59).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg in view of Terschluse to launch the internet application into PC as suggested by Vaziri in order to enable the user to receive the internet calls on the PC, which will give the ability also to have a video conversation so the both parties can talk and see each other.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (US Patent 6,091,721) in view of Terschluse (US Patent 6,118,857) and further in view of Noonan (US Patent 5,761,280).

Regarding claim 12, Greenberg in view of Terschluse discloses, the predetermined sequence of DTMF digits comprises (for example \*PGM; Col. 6, lines 32-

40; so when the user presses this sequence an internet call is activated).

Greenberg in view of Terschlude does not expressly disclose that the predetermined sequence is selected from the group consisting of "##", "\*\*\*" and "#\*\*"

However it is obvious to one with ordinary skill in the art to try different sequences when program the interface adapter to receive/make an internet call when pressing these sequences

Noonen discloses a telephone web browser arrangement and method, when the phone is in the call mode, the user may initiate various commands using DTMF signals to enter the phone into various mode, one of the DTMF code sequence is "##" (Col. 4, lines 9-17).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg in view of Terschlude, to provide that the predetermined sequence of DTMF comprising "##" as taught by Noonan in order to make it easier for the user to have two consecutive characters "##" to press when he desire to toggle between PSTN and internet telephony service.

9. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (US Patent 6,091,721) in view of Terschlude (US Patent 6,118,857) and further in view of Frantz (US Patent 6,167,043).

Regarding claim 14, Greenberg in view of Terschlude discloses, an interface that is coupled to the PC (Terschlude: Col. 4, lines 33-35; the modem is connected to a computer via connectors 2a and 2b).

Greenberg in view of Terschluse does not disclose that the interface has a PCI or ISA form factor.

Frantz in similar art of endeavor discloses, system for provide ranch exchange allowing simultaneous data and voice communication. The system include a modem (Fig. 1, el. 9) may be installed in the personal computer (Fig. 1, el. 13) such as an ISA internal modem, the interconnect (Fig. 1, el. 11) may be ISA bus or a PCI bus (Col. 57-60).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Greenberg in view of Terschluse with Frantz teaching, by having that the interface has a PCI or ISA form factor, in order to simplify the connectivity to a computer.

Regarding claim 15, Greenberg in view of Terschluse and further in view of Frantz discloses, the interface comprises a portion of a modem circuit or sound card. (Terschluse: Col. 5, lines 64-66) and (Frantz: Col. 3, lines 32-50).

10. Claims 30 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 6,169,734) in view of Terschluse (US Patent 6,118,857).

Regarding claim 30, Wilson discloses, an internet phone as claimed in 26-29.

Wilson does not disclose circuitry for detecting a call waiting signal.

Terschluse in similar art of endeavor discloses that when the phone detect a call

Art Unit: 2614

waiting signal, this signal is received on the PC where the user can have an internet call. The phone comprising circuitry for detecting a call waiting signal (Terschluse: Col. 2, lines 23-25, Col. 4, lines 56 through Col. 6, lines 1-39; the detection device el. 6 that detect the presence of a call waiting signal).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Wilson telephone to have a call-waiting circuit as suggested by Terschluse, in order to notify the user of a second incoming call.

Regarding claim 46, claim 46 is rejected for same reasons for claim 30.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 26-29, 31-32, 42-45 and 47-48 are rejected under 35 U.S.C. 102(e) as being unpatentable by Wilson (US Patent 6,169,734).

Regarding claim 26, Wilson discloses, telephone (Fig. 2) comprising:  
a jack adapted to be coupled to a telephone network (Fig. 2, el. 82)  
an analog telephone circuit (Col. 4, lines 43-50) a microprocessor (Fig. 3, el. 116) a



modem coupled to the microprocessor (Fig. 3, el. 112) and modem for transmitting digitized voice signals over the Internet (see Fig. 3) and a switching circuit having a first position wherein the analog telephone circuit is coupled to the jack for transmitting and receiving analog voice signals over the telephone network, and a second position wherein the analog telephone circuit is coupled to the jack through the microprocessor (Col. 4, lines 23-56; Wilson discloses a switching button Fig. 2, el. 69 which allow the user to switch between a first position "regular calls through PSTN" or a second position which reads on "internet dial operation" so the limitation switching circuit is inherently met).

Regarding claim 27, Wilson discloses, a digital signal processor (Col. 2, lines 45-46).

Regarding claim 28, Wilson discloses, a coding/decoding circuit (Col. 2, lines 45-47).

Regarding claim 29, Wilson discloses, a subscriber line interface circuit coupled between the analog telephone circuit and the microprocessor (Col. 5, lines 1-4).

Regarding claim 31, Wilson discloses, circuitry for detecting a ring signal (Fig. 3, el. 104).

Regarding claim 32, Wilson discloses, a button and the switching circuit moves between the first and second positions responsive to actuation of the button (Col. 4,

Art Unit: 2614

lines 22-29).

Regarding claims 42-45 are rejected for the same reasons in claims 26-29 (see the analysis of claims 26-32).

Regarding claims 47-48 are rejected for the same reasons in claims 31-32.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 33-41 and 49-57 are rejected under 35 U.S.C. 102(b) as being unpatentable by Greenberg (US Patent 6,091,721).

Regarding claim 33, Greenberg discloses, method of selectively coupling an analog telephone circuit to either a telephone network or an Internet telephony service (Col. 1, lines 59-65 and Col. 5, lines 66-67 through Col. 6, lines 1-9) the method comprising:

providing apparatus adapted to be coupled to a telephone line (Fig. 1, el. 12) the apparatus including a jack and an analog telephone circuit (Fig. 3, el. 31 and 37), a microprocessor (Fig. 3, el. 40), a modem (Fig. 3, el. 50), and a switching circuit (Fig. 3, el. 33) the switching circuit having a first position wherein the analog telephone circuit is coupled to the jack for transmitting and receiving analog voice signals over the telephone network (Fig. 3; when the switch is connect to the line 34), and a second position wherein the analog telephone circuit is coupled to the jack through the microprocessor and modem for transmitting digitized voice signals over the Internet;

(Fig. 3, when the switch on line 46 and also see Col. 6, lines 6-59) coupling the jack to the telephone line (Col. 5, lines 36-50) and if it is desired to connect to the telephone network dialing a telephone number while the switching circuit is in the first position (Col. 5, lines 51-67 through Col. 6, lines 1-5) if it is desired to place an Internet-based telephone call, actuating the switching circuit to cause the switching circuit to move to the second position (Col. 6, lines 6-59).

Regarding claim 34, Greenberg discloses, after moving the switching circuit to the second position, executing an Internet-based telephony application by the microprocessor (Col. 7, lines 54-65).

Regarding claim 35, Greenberg discloses, establishing an Internet-based telephone call (Col. 6, lines 6-7 and Col. 7, lines 13-14).

Regarding claim 36, Greenberg discloses, during the pendency of an Internet-based telephone call receiving a ring signal that there is an incoming call and generating a user-perceptible signal responsive to receipt of the ring signal (Col. 7, lines 31-44; when the user on the phone, he/she can be alert of incoming call through a computer or a video interface).

Regarding claim 37, Greenberg discloses, the telephone further comprises a button coupled to the switching circuit, the method further comprising: actuating the button to cause the switching circuit to move from the second to the first position and accepting the incoming call (Col. 8, lines 60-63)

Regarding claim 38, Greenberg discloses, after accepting the incoming call, actuating the button again to return to the Internet-based telephone call (Col. 6, lines 17-58 and Col. 7, lines 44-50)

Regarding claim 39, Greenberg discloses, during the pendency of an Internet-based telephone call receiving a ring signal that there is an incoming call and generating a user-perceptible signal responsive to receipt of the ring signal (Col. 7, lines 31-44; when the user on the phone, he/she can be alert of incoming call through a computer or a video interface).

Regarding claims 40-41 are rejected for the same reasons in claims 37-38.

Regarding claim 49 is rejected for same reasons in claim 33; (see the analysis of claim 33; regarding the limitation "coupled a first jack to a telephone" it reads on Greenberg Fig. 3, el. 31, and for the limitation "coupled a telephone line through a second jack" it reads on Greenberg Fig. 2, el. 14)

Regarding claims 50-57 are rejected for the same reasons for claims 34-41 (see the analysis of claims 34-41).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA EL-ZOOBI whose telephone number is

Art Unit: 2614

(571)270-3434. The examiner can normally be reached on Monday-Friday (8AM-5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fan Tsang/  
Supervisory Patent Examiner, Art Unit 2614

/M. E./  
Examiner, Art Unit 2614  
/Maria El zoobi/  
Examiner, Art Unit 2614